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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/534,772	03/22/2007	Stephen Tomlinson	577712000200	1737

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MORRISON & FOERSTER LLP  
755 PAGE MILL RD  
PALO ALTO, CA 94304-1018

EXAMINER
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CARLSON, KAREN C

ART UNIT	PAPER NUMBER
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1656

MAIL DATE	DELIVERY MODE
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12/15/2008

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/534,772

**Applicant(s)**

TOMLINSON ET AL.

**Examiner**

Karen Cochrane Carlson

**Art Unit**

1656

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1, 2, 4-10, 15-17, 19, 27-31, 33, 41, 46-59 and 74-78 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1, 2, 4-10, 15-17, 19, 27-31, 33, 41, 46-59, 74-78 are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_.

Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

Group 1, claim(s) 5, 52, drawn to compositions comprising CR2 and DAF.

Group 2, claim(s) 6, drawn to compositions comprising CR2 and NO: 10.

Group 3, claim(s) 7, drawn to compositions comprising CR2 and NO: 6.

Group 4, claim(s) 8-10, 17, 52, and 54, drawn to compositions comprising CR2 and CD59.

Group 5, claim(s) 15, 16, 52, 53, drawn to compositions comprising CR2 and NO: Cry.

Group 6, claim(s) 27, 28, 52, drawn to compositions comprising CR2 and CVF.

Group 7, claim(s) 29, 74-77, drawn to compositions comprising CR2 and NO: Ig.

Group 8, claim(s) 30, 31, 33, 41, 56-58, 78, drawn to a method of treatment using compositions comprising CR2 and DAF.

Group 9, claim(s) 30, 31, 33, 41, 56-58, 78, drawn to a method of treatment using compositions comprising CR2 and CD59.

Group 10, claim(s) 30, 31, 33, 41, 56-58, 78, drawn to a method of treatment using compositions comprising CR2 and NO: Cry.

Group 11, claim(s) 30, 31, 33, 41, 56-58, 78, drawn to a method of treatment using compositions comprising CR2 and CVF.

Group 12, claim(s) 79-82, drawn to a method of treatment using compositions comprising CR2 and NO: Ig.

Group 13, claim(s) 46, drawn to a method for decreasing complement mediated damage using compositions comprising CR2 and DAF.

Group 14, claim(s) 46, drawn to a method for decreasing complement mediated damage using compositions comprising CR2 and CD59.

Group 15, claim(s) 46, drawn to a method for decreasing complement mediated damage using compositions comprising CR2 and NO: Cryy.

Group 16, claim(s) 46, drawn to a method for decreasing complement mediated damage using compositions comprising CR2 and CVF.

Group 17, claim(s) 47, drawn to a method for increasing complement mediated damage using compositions comprising CR2 and DAF.

Group 18, claim(s) 47, drawn to a method for increasing complement mediated damage using compositions comprising CR2 and CD59.

Group 19, claim(s) 47, drawn to a method for increasing complement mediated damage using compositions comprising CR2 and NO: Cryy.

Group 20, claim(s) 47, drawn to a method for increasing complement mediated damage using compositions comprising CR2 and CVF.

Group 21, claim(s) 55, drawn to a method for targeting a modulator using compositions comprising CR2 and DAF.

Group 22, claim(s) 55, drawn to a method for targeting a modulator using compositions comprising CR2 and CD59.

Group 23, claim(s) 55, drawn to a method for targeting a modulator using compositions comprising CR2 and NO: Cryy.

Group 24, claim(s) 55, drawn to a method for targeting a modulator using compositions comprising CR2 and CVF

Claims 1, 2, 4, 19, 48-51 and 78 link(s) any one of inventions 1-7, or 8-12, or 13-16, or 17-20 or 21-24. The restriction requirement between the linked inventions is

**subject to** the nonallowance of the linking claims. Upon the indication of allowability of the linking claim(s), the restriction requirement as to the linked inventions **shall** be withdrawn and any claim(s) depending from or otherwise requiring all the limitations of the allowable linking claim(s) will be rejoined and fully examined for patentability in accordance with 37 CFR 1.104 **Claims that require all the limitations of an allowable linking claim** will be entered as a matter of right if the amendment is presented prior to final rejection or allowance, whichever is earlier. Amendments submitted after final rejection are governed by 37 CFR 1.116; amendments submitted after allowance are governed by 37 CFR 1.312.

Applicant(s) are advised that if any claim presented in a continuation or divisional application is anticipated by, or includes all the limitations of, the allowable linking claim, such claim may be subject to provisional statutory and/or nonstatutory double patenting rejections over the claims of the instant application. Where a restriction requirement is withdrawn, the provisions of 35 U.S.C. 121 are no longer applicable. *In re Ziegler*, 443 F.2d 1211, 1215, 170 USPQ 129, 131-32 (CCPA 1971). See also MPEP § 804.01.

The inventions are independent or distinct, each from the other because:

Inventions I-7 are used in anyone of the processes of Inventions 8-12, 13-16, 17-20, or 21-24.

Inventions I-7 and Inventions 8-12, 13-16, 17-20, or 21-24 are related as product and process of use. The inventions can be shown to be distinct if either or both of the

following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product. See MPEP § 806.05(h). In the instant case the products can be used in any one of the methods claimed.

The methods of Inventions 8-12, 13-16, 17-20, or 21-24 are related in that they use the compositions of Inventions 1-7. However, the steps and endpoints of the methods are divergent and therefore patentably distinct.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

The examiner has required restriction between product and process claims. Where applicant elects claims directed to the product, and the product claims are subsequently found allowable, withdrawn process claims that depend from or otherwise require all the limitations of the allowable product claim will be considered for rejoinder. All claims directed to a nonelected process invention must require all the limitations of an allowable product claim for that process invention to be rejoined.

In the event of rejoinder, the requirement for restriction between the product claims and the rejoined process claims will be withdrawn, and the rejoined process claims will be fully examined for patentability in accordance with 37 CFR 1.104. Thus, to

be allowable, the rejoined claims must meet all criteria for patentability including the requirements of 35 U.S.C. 101, 102, 103 and 112. Until all claims to the elected product are found allowable, an otherwise proper restriction requirement between product claims and process claims may be maintained. Withdrawn process claims that are not commensurate in scope with an allowable product claim will not be rejoined. See MPEP § 821.04(b). Additionally, in order to retain the right to rejoinder in accordance with the above policy, applicant is advised that the process claims should be amended during prosecution to require the limitations of the product claims. **Failure to do so may result in a loss of the right to rejoinder.** Further, note that the prohibition against double patenting rejections of 35 U.S.C. 121 does not apply where the restriction requirement is withdrawn by the examiner before the patent issues. See MPEP § 804.01.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Karen Cochrane Carlson whose telephone number is 571-272-0946. The examiner can normally be reached on 7:00 AM - 4:00 PM, off alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dr. Jon Weber can be reached on 571-272-0925. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Karen Cochrane Carlson/  
Primary Examiner, Art Unit 1656